

REMARKS

This Amendment is in response to the Examiner's Final Office Action mailed April 11, 2003. In response to the Final Office Action, the applicants submit the following proposed amendments to claims 1, 2, 4, 5, 12-16, and 18-20. Further, the specification and drawings have been amended as explained to address certain objections of the Examiner. Claims 1 through 21 remain in the Application for examination by the Examiner.

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) because the Examiner believed the inclusion of the adhesive and the suction cup in one figure was overly confusing. The applicants respectfully traverse this objection because the specification clearly explains the references. However, in order to expatiate this case to allowance, the applicants have submitted new figures addressing this concern. Further, the applicants have replaced portions of the specification corresponding to new figures. The applicants respectfully submit that no new matter has been added to the specification by virtue of the amendments to the drawing and specification.

In light of the above, the applicants respectfully request that the Examiner withdraw the objection to the drawings.

The Rejection under 35 U.S.C. § 112, first paragraph.

In the August 20, 2003 Final Office Action, the Examiner rejected claims 1-21 for containing "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." In particular, the Examiner is of the opinion that the recitation of "resilient cup" was not sufficiently disclosed. The applicants respectfully traverse this rejection.

As an initial matter, the applicants simply cannot decipher the Examiner's comments regarding the rejection. Initially, the Examiner claims the recitation is

not sufficiently disclosed by the specification. Then, the Examiner explicitly outlines where in the specification the term is disclosure and how one of ordinary skill in the art would interpret the claim. Thus, as the Examiner points out, the specification specifically outlines the term resilient and how the term would be understood by one of skill in the art, it is simply incomprehensible how a term, sufficiently disclosed and explained in the original filing could subsequently be considered new matter.

Moreover, any one who has played baseball, yet alone someone or ordinary skill in the industry, would understand the term resilient as used in the context of the specification. In particular, the description of resiliency similar to a baseball glove would provide someone with a range of resilient allowable because gloves have various resiliencies depending on a number of factors, such as, for example, the brand of the glove, how broken in the glove is, whether the glove has been oil, oiled slightly, moderately, or heavily, etc. Thus, because the term resilient is defined in the specification as similar to a baseball glove and the resiliency of a baseball glove would be reasonably determinable to one of ordinary skill in the art without undue experimentation, it is respectfully submitted that the recitation of the term resiliency should not have been rejected under 35 U.S.C. § 112, first paragraph.

Finally, the Examiner rejected claims in view of the Genjack. In particular, the Examiner stated the Genjack reference inherently disclosed a level of resiliency because it was designed to catch a ball. If resiliency can be inherent in the Genjack reference, then how a specific disclosure and explanation of the term in the specification fails to explain under 35 U.S.C. § 112, first paragraph, is simply not understandable.

Be that as it may, the applicants did not consider the recitation of the resiliency of the cup to be a necessary, although sufficient, claim limitation to overcome the Genjack reference. Because the recitation of resiliency is unnecessary, and because the applicants cannot decipher the Examiner's rejection

under 35 U.S.C. § 112, first paragraph, and because resources are limited, the recitation has been removed from the claims. Because the claims no longer recite the resilient limitation, the applicants respectfully request the Examiner withdraw the rejection of the claims under 35. U.S.C. § 112, first paragraph.

The Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 2, 4-11, 13-16, 18, and 20 under 35 U.S.C. § 102(b). The applicants respectfully traverse the rejection. In particular, as amended, claim 1 recites a combination of elements, including, for example, "the at least one cup having an outer diameter of greater than about 6 inches," which is disclosed in the original specification, that is neither disclosed nor suggested by Genjack, either alone or in any reasonable combination with the other references of record. At most, Genjack discloses a funnel shape device where the largest outer diameter is somewhat smaller than the span of a person's palm, see figure 2 of Genjack. Further, as shown in figure 1 of Genjack, the funnel shape device has an outer diameter somewhat smaller than the ball, such that the Genjack device is more of a tee, than a catch. Unlike the device disclosed in Genjack, the bunt cup of the present invention must have an outer diameter greater than the diameter of the ball being used to function to simulate catching a ball in a manner similar to a glove. In other words, the ball enters the pocket or web of a glove and similarly enters the funnel of the bunt cup. Thus, it is respectfully submitted that amended claim 1 is patentably distinct from Genjack either alone or in any reasonable combination with the other references of record.

Amended independent claims 13 and 18 have been amended to include the limitations similar to claim 1 above and, by virtue of the similarity, it is respectfully submitted that amended independent claims 13 and 18 are patentably distinct from Genjack either alone or in any reasonable combination with the other references of record. Claims 2, 4-11, 14-16, and 20 depend, either directly or indirectly, from amended independent claims 1, 13, and 18 and, by virtue of

this dependency, are also patentably distinct from Genjack either alone or in any reasonable combination with the other references of record.

The Examiner additionally rejected claims 13, 14, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by Tyner. The applicants respectfully traverse the rejection. In particular, Tyner discloses a tubular device similar to a foam sleeve that slips over a bat end, for example. Tyner does not disclose, suggest, nor can be modified, to have a “means for simulating the catching of a ball with the bat” where the means for simulating the catching of the ball has an outer diameter of greater than about 6 inches. Because Tyner does not disclose, teach, or suggest an outer diameter of greater than about 6 inches, the applicants respectfully submit that claims 13, 14, 16, and 17 are patentably distinct from Tyner either alone or in any reasonable combination with the references of record.

The Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 3, 12, 19, and 21 under 35 U.S.C. § 103(a) as being unpatentable and obvious over Genjack. Claims 3, 12, 19, and 21 depend, either directly or indirectly, from claims 1 and 18. By virtue of the dependency, claims 3, 12, 19, and 21 are all patentably distinct from Genjack either alone or in any reasonable combination with the other references of record.

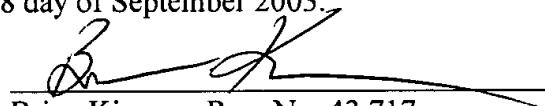
Conclusion

The applicants respectfully requests that the Examiner to consider this Amendment After Final Office Action Under 37 C.F.R. § 1.116. The applicants submit that claims 1-21 are presently in condition for allowance and that no new matter has been introduced by this response. The applicants believe that the proposed response does not raise new issues or necessitate the undertaking of any additional search of art by the Examiner, because all of the elements were either earlier claimed or inherent in the claim as examined. Therefore, the amendment should allow for immediate action by the Examiner. Alternatively, the Applicant

believes that entry of the response would place the application in better form for appeal, should the Examiner dispute the patentability of the claims.

If an extension of time under 35 C.F.R. § 1.136 is required to obtain entry of this Amendment, such an extension is requested. If there are fees due under 37 U.S.C. §§ 1.16 or 1.17 which are not otherwise accounted for, please charge our Deposit Account No. 08-2623.

Respectfully submitted this 18 day of September 2003.



Brian Kinnear, Reg. No. 43,717
Attorney for Applicant
HOLLAND & HART LLP
555-17th Street, Suite 3200
P.O. Box 8749
Denver, Colorado 80201
(303) 295-8170

3132407_1.DOC